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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Application No. 09/208,696

Applicant: YASUYUKI SEKINE

Filed: December 10, 1998

TC/AU: 3711

Examiner: D. Collins

Docket No.: 403072

Customer No.: 23460

**TRANSMITTAL OF
APPELLANT'S BRIEF**

U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief - Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Dear Sir:

In accordance with 37 CFR 41.37, Appellant submits his Brief on Appeal.

The items checked below are appropriate:

1. Status of Appellant

This application is on behalf of ☒ other than a small entity or ☐ a small entity.

2. Fee for Filing Brief on Appeal

Pursuant to 37 CFR 41.20(2), the fee for filing the Brief on Appeal is for: ☒ other than a small entity or ☐ a small entity.

Brief Fee Due \$500.

3. Oral Hearing

☐ Appellants request an oral hearing in accordance with 37 CFR 41.47.

A separate paper requesting oral hearing is attached.

12/28/2005 JADD01 00000013 121216 09200696
02 FC:1251 120.00 DA

4. Extension of Time

- ☒ Appellant petitions for a one-month extension of time under 37 CFR 1.136, the fee for which is \$120.

Pursuant to the Official Gazette Notice of July 12, 2005, a Request for Pre-Brief Review was filed. The Notice of Panel Decision was mailed October 27, 2005. Pursuant to the Notice, the deadline for filing of Appellant's Brief without extension of time fees, was then re-set to November 27, 2005. Accordingly, only a one-month extension of time fee is payable with the filing of the attached Appellant's Brief on December 27, 2005.

- ☐ Appellants believe that no extension of time is required. However, this conditional petition is being made to provide for the possibility that appellants have inadvertently overlooked the need for a petition and fee for extension of time.

Extension fee due with this request: \$120.

5. Total Fee Due

The total fee due is:

Brief on Appeal Fee	\$500
Request for Oral Hearing	\$ 0
Extension Fee (if any)	\$120

Total Fee Due: \$620

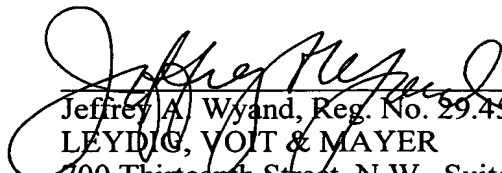
6. Fee Payment

- ☐ Attached is a check in the sum of \$
- ☒ Charge Account No. 12-1216 the sum of \$620. A duplicate of this transmittal is attached.

7. Fee Deficiency

- ☒ If any additional fee is required in connection with this communication, charge Account No. 12-1216. A duplicate copy of this transmittal is attached.

Respectfully submitted,


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Date:

December 27, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Patent Application No. 09/208,696

Applicant: YASUYUKI SEKINE

Filed: December 10, 1998

TC/AU: 3711

Examiner: D. Collins

Docket No.: 403072

Customer No.: 23548

APPELLANT'S APPEAL BRIEF

U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief - Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Dear Sir:

In support of the appeal from the final rejection dated July 5, 2005, as modified November 1, 2005, Appellant now submits his Brief.

Status of the Appeal

The Notice of Appeal in this patent application was filed September 9, 2005. Simultaneously, a Pre-Appeal Brief Request for Review was filed pursuant to the Official Gazette notice of July 12, 2005. At the time of filing that Request, all pending claims were finally rejected as unpatentable over Ugawa (JP 5-68733)¹ in view of Hooker (U.S. Patent 4,184,683). Page 2 of the Request pointed out that Hooker was irrelevant to the rejection of any pending claim. In fact, Hooker only was pertinent to claim limitations that appeared in claims that were cancelled on July 7, 2004.

A Notice of Panel Decision mailed October 27, 2005, indicated that the prosecution of this patent application was to be re-opened. On November 1, 2005, an Office Action with a final rejection was mailed. However, prosecution was not re-

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¹ The principal reference has been consistently identified by the Examiner with reference to the Applicant, Sankyo, and by Appellant's current representative as Ugawa, the name of the inventor.

opened, contrary to the Notice of October 27, 2005. The only substantive change in the Office Action mailed November 1, 2005, as compared to the Office Action of July 5, 2005, was the deletion of the reliance on Hooker. All pending claims were rejected as obvious over Ugawa. This “new” final rejection was identical in substance to the final rejection previously made.

What is meant by re-opening prosecution is illuminated by 37 CFR 41.39(b). That sub-section points out that when an examiner’s answer “contains a rejection designated as a new ground of rejection” an appellant has the option of re-opening prosecution or pursuing his appeal. Clearly, what is meant by re-opening prosecution is responding to a new or different ground of rejection. No statement appears anywhere within the Office Action mailed November 1, 2005 asserting that deletion of an irrelevant secondary reference, without a change in application of the primary reference, constitutes a new or different ground of rejection. Thus, prosecution of this application was not re-opened on November 1, 2005.

According to the Official Gazette notice, the time period for filing an Appeal Brief from an adverse Panel Decision in a Pre-Appeal Brief Review is the later of one month from the mailing of the Decision or the remainder of the two-month period measured from the date of filing of the Notice of Appeal. The Official Gazette notice also contained inconsistent information with regard to the deadline for the filing of an Appeal Brief in response to an unfavorable Panel Decision. Appellant’s representative was assured by Mark O. Polutta (571-272-7709) of the Office of Patent Legal Administration (OPLA) that the deadline for filing the Appeal Brief in the present circumstances was November 27, 2005, subject to extension pursuant to 37 CFR 1.136.

In view of the advice of the U.S. Patent and Trademark Office and the failure to re-open prosecution, in spite of the contrary statement, Appellant has chosen to pursue his appeal consistent with the July 12, 2005 Official Gazette notice.

Real Party In Interest

The patent application that is the subject of this appeal is assigned to Aruze Corporation of Tokyo, Japan.

Related Appeals and Interferences

There are no prior or pending appeals, interferences, or judicial proceedings which may be related to, directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal.

Status of Claims

This patent application has been pending before the same Examiner for more than seven years. The application was filed with claims 1-10. In the course of the lengthy prosecution, claims 10-32 were added and claims 1-10 were cancelled, leaving claims 17-32 pending. All of those claims 17-32 are finally rejected. The final rejection of all of claims 17-32 is appealed. The claims on appeal are reproduced in the Appendix.

Status of Amendments

No Amendment was filed in response to the final rejection of July 5, 2005 nor to the clarification in the Office Action mailed November 1, 2005.

Summary of Claimed Subject Matter

The invention pertains to a display for a game machine that falls within the scope of what is commonly regarded as a slot machine. An example of such a machine 1 is illustrated in Figure 2 of the patent application. That machine includes three vertical side-by-side display areas 4L, 4C, and 4R. Known slot machines employ mechanical apparatus, such as rotating reels, to which reel sheets can be attached. The reel sheets contain symbols that relate to winning and losing of the game of chance provided by the machine. In more modern machines, the reels are simulated electronically with video images supplying the symbols. In any event, the reels according to the invention, as in conventional game machines, rotate about a common axis but rotate independently prior to stopping to display an arrangement of symbols that may or may not reward the player of the game. Reels according to the invention are indicated in Figures 3-7 of the patent application with the designations 4L, 4C, and 4R, just as illustrated in Figure 2.

Each of the reels includes a respective reel sheet containing a plurality of symbols that are sequentially arranged. Figure 1 illustrates three such reels 100L, 100C, and 100R that may be employed with a machine having three reels. Clearly, the invention as

defined by claim 17 may have only two such reels and reel sheets or more than three reels and reel sheets.

As described in claim 17, each of the reel sheets includes one symbol appearing serially, at least two times, without any intervening different symbol. Referring to Figure 1, for example, in the reel sheet 100L, three bell symbols appear serially without any intervening different symbol. In the reel sheet 100C, such repeating symbols are represented by plums. In the third reel sheet, 100R, the cherry symbol appears three times without interruption by an intervening different symbol. Further, according to the invention, every symbol that appears on any reel sheet appears on every one of the reel sheets. This condition can be seen to be fulfilled in the example of Figure 1 of the patent application.

The invention according to claim 1 provides that the display includes a display window for viewing symbols on the reels along at least two straight lines when the reels are stopped. The specific embodiments described in the patent application, for example, in Figures 3-7, as well as in Figure 2, show a display window that includes a matrix of nine symbols, three symbols on each of three reel sheets being simultaneously displayed when the reels stop rotation. In the invention, alignments on at least one of the straight lines of the display window of specific combinations of symbols provide a winning state for the player of the game and all other combinations of symbols along the straight lines do not provide a winning state for a player. Considering diagonal straight lines as illustrated in Figure 4 of the patent application, it can be seen that five potentially winning alignments are provided in that embodiment.

As explained in greater detail with respect to the prior art rejection, the arrangement of the symbols on the reel sheets, which may seem arbitrary in an isolated reading of claim 17, provides an important advantage over the prior art. In the prior art an alignment of identical symbols along a single straight line of the display may not provide a winning state and a reward for a player. Ugawa, the sole publication applied in rejecting the claims, provides an arrangement of symbols that cannot result in an alignment of the same symbol along a single straight lines that is not a winning state for a player. The invention provides a different solution to the same problem, a solution not provided by nor suggested by Ugawa.

The dependent claims likewise find clear support in the application as filed. Claims 18-20 relate to a display that includes, in each display window, three symbols (claim 18) and a display that includes three reels (claims 19 and 20). These claims are all supported by at least Figures 2-7 of the patent application showing displays with three reel sheets and three symbols displayed on each reel sheet in the window.

Claims 21, 22, 26, 27, and 32 all relate to combinations of the displayed symbols that produce winning and losing states, as described in the patent application for specific embodiments with regard to Figure 8. That figure shows such winning and losing combinations.

Claim 23 describes the symbols that appear on the reel sheets at least two times without any intervening different symbol as appearing three times on each reel. This claim is supported by Figure 1 of the patent application where the repeating symbols 101, 102, and 103 on the respective reel sheets each appear three times without any intervening different symbol.

Claim 24 describes the repeating symbols as being of different colors as described in the patent application at page 9, lines 11-14. (There are no color figures in the patent application.) Claim 25 specifies that the repeating symbols on each of the reels is different on each of the reels as shown in Figure 1 of the patent application. Claim 28 specifies that each symbol that appears serially on one reel also appears, although not serially, without any intervening symbol, on the other reel sheets. It is clear from studying Figure 1 that the bell symbols that repeats on the reel 100L likewise appears on both of the reels 100C and 100R, but without repetition. Claim 29 specifies that the game has a cabinet, as illustrated in Figure 2 of the patent application, on which an award table is displayed. Display of the award table on the cabinet is described at page 14 of the patent application in lines 22 and 23. Finally, claims 30 and 31 describe the straight lines along which determinations of winning or losing states are made as being parallel to the axis along which the reels rotate or oblique to that axis. These claims are clearly supported by at least Figures 4-7 of the patent application and the corresponding description.

Grounds of Rejection to be reviewed on Appeal

Are any of claims 17-32 obvious in view of Ugawa considered by itself? In accordance with the clarification of the final rejection in the Office Action of November 1, 2005, Appellant does not again refer to Hooker, an irrelevant reference conceded to have no pertinence to the invention defined by the claims on appeal.

Argument - Claim 17

Since claim 17 is the sole independent claim, if that claim, rejected as obvious over Ugawa considered by itself, is patentable, then so are claims 18-32. By rejecting claims 17-32 as obvious over Ugawa, the Examiner acknowledges that Ugawa does not disclose the claimed invention.

Only limited English language information is available concerning Ugawa, namely an English language abstract and a computer-generated translation from the JPO website of Ugawa that has not been made of record in this prosecution. Those sources and the advice of the Appellant show that Ugawa describes an apparatus with three rotating reels including reel sheets having particular symbols arranged according to Figure 22 of Ugawa. The English language abstract of Ugawa, upon careful analysis, states that the only winning combinations of symbols in Ugawa include either a number “7” or a “bar” symbol which, in Figure 22 of Ugawa, resembles a crest with the word “bar” across the center of the crest. Therefore, whenever a bell symbol appears at any location of the display or whenever a watermelon appears at any position on the display, the player of the machine recognizes that he has lost the game. That information from the English language abstract as well as from paragraphs [0003] and [0004] of the computer-generated translation of Ugawa nevertheless does not provide to one of skill in the art an understanding of the reason for the arrangement of symbols on the Ugawa reel sheets. Therefore, a further discussion of that reason is provided below.

The fundamental difference between the invention as described in claim 17 and Ugawa is quite easily demonstrated by comparing the language of claim 17, illuminated by the reels of Figure 1 of the patent application, and the most pertinent figure of Ugawa, its Figure 22. Figure 22 of Ugawa shows symbols appearing on three reels of a slot machine.

There are two fundamental limitations of claim 17 with regard to the arrangement of the symbols on the reel sheets.

- 1. Each reel sheet includes one symbol appearing serially, at least two times, without any different intervening symbol; and*
- 2. Each symbol of the plurality of symbols appears on each of the reel sheets.*

Ugawa fails to disclose the conjunction of these two conditions. That failure is not happenstance, but intentional, in Ugawa, demonstrating that claim 17 is patentable over Ugawa. As shown in Figure 22 of Ugawa, Ugawa's three reel sheets include as symbols a bell, the number 7, a bar, and a watermelon. No pair of these reel sheets is within or suggests claim 17.

Considering the left and center reel sheets of Figure 22 of Ugawa as a plurality of reel sheets, it is apparent that neither of conditions 1 and 2 is fulfilled. Condition 1 is not met by the center reel sheet because there is no symbol appearing at least twice without any intervening different symbol on that reel sheet. Condition 2 is not met because the watermelon symbol does not appear on the left reel sheet.

Considering the left and right reel sheets of Figure 22 of Ugawa, condition 2 is not met. The left reel sheet, as already indicated, does not include the watermelon symbol so that each symbol of the plurality of symbols does not appear on each of the reel sheets. Likewise, the right reel sheet does not include the bell symbol, also failing to meet condition 2.

The final potential combination of two of the reel sheets of Figures 22 of Ugawa is the center reel sheet and the right reel sheet. As already described, the center reel sheet does not meet condition 1 because there is no repetition of any symbol at least twice without any intervening different symbol. The right reel sheet, as already mentioned, does not meet condition 2 because the bell symbol does not appear, meaning that each symbol of the plurality of symbols does not appear on each of the reel sheets.

It follows, from having considered all possible permutations of the Ugawa reel sheets, taken two at a time, that the three reel sheets, considered together, cannot meet both of conditions 1 and 2 of claim 17. In other words, no plurality of Ugawa's reel sheets includes on each sheet a serially repeating symbol, without intervening different symbols and not every symbol appears on every reel sheet.

Of course, the Examiner acknowledged this difference but asserted, as stated in the Office Action mailed November 1, 2005, that the difference between Ugawa and what is claimed would be supplied by “mere duplication to include symbols in serial [sic] on the center reel. Such duplication is well known in the art.” This alleged “duplication” has not been proven or even supported by any objective evidence or information in any Office Action throughout the protracted prosecution of this patent application.

The Examiner continued at page 3 of the Office Action of November 1, 2005,

“Furthermore, implicit in [Ugawa’s] teaching is appearance of each symbol on each reel since his invention teaches three “7” or “Bar” (or other patterns) visible through 202, 203 & 204 is the probability being sought [0058]. Since other patterns may be used, to meet these criteria all patterns would need to be on each reel.

With respect, Applicant can parse only scant meaning from this paragraph and cannot apply the paragraph to the legal issue of obviousness.

The statement that Ugawa teaches that each symbol appears in each reel sheet has been shown above to be wrong for some pairs of Ugawa’s reel sheets and for the three reel sheets considered together. The contrary statement at the end of the rejecting paragraph is untrue.

The English language abstract of Ugawa and paragraph [0058]², to the extent comprehensible from the computer-generated translation, establish that a winning state in Ugawa’s game machine requires display of “7” and “BAR” symbols. Nowhere on any of Ugawa’s reel sheets are these “winning” symbols repeated at least twice without

² Paragraph [0058] according to the computer-generated translation follows.

“The information drawn on the peripheral surface of the rotating drum 187,188,189 mentioned above at equal intervals is a pattern that is shown in drawing 22 R> 2. In this example, when “7” of an example of the identification information for a hit is located in a line with an aperture 202,203,204 at a horizontal single tier among the information shown in Fig. 22, or when “BAR” of an example of the identification information for a hit is located in a line with an aperture 202,203,204 at a horizontal single tier, it will be in the predetermined game condition defined beforehand, and grant of a predetermined game value will be attained. When the probability is calculated from the display of drawing 22, on the left drum 189, those with three and the probability for “7” to appear are “3/10”, in the inside drum 188 and the right drum 187, “7” is one at a time, respectively, and, as for those probabilities to appear, “7” is 1/10”, respectively. Therefore, the probability for three “7” together will be called “3/1000” which carried out the multiplication of each probability. Moreover, the identification information for blanks is constituted among the various patterns shown by drawing 22 by patterns other than “7” and “BAR.””

intervening different symbols. What is meant in the rejection by “mere duplication” or what “mere duplication” might produce cannot be discerned from Ugawa or the final rejection.

It is well established in U.S. patent law that to demonstrate *prima facie* obviousness, it is the Examiner’s burden to show, through prior art publications or other knowledge well known in the art, that it would have been obvious to modify a primary reference, here Ugawa, with a teaching from a secondary reference, here nothing, to produce the invention claimed. The examination analysis here is fatally flawed because there has been no showing that the admitted differences between claim 17 and Ugawa are suggested by Ugawa or anything else. This error requires reversal of the rejection, even without consideration of the further evidence of the errors in the rejection that is presented below.

Since the Applicant of the present application is Japanese, a reliable description of the disclosure of Ugawa was provided during prosecution. In slot machines preceding the Ugawa disclosure, the symbols that appeared in a display when the reels stopped spinning may be identical in each of three windows without producing a winning state. The natural reaction to the matching of displayed symbols was that a prize had been won. However, in those prior art slot machines an award table had to be consulted to determine if a particular combination of symbols was a winner. When the award table showed that the display of the three identical symbols was not a winner and the player failed to receive the expected prize, extreme disappointment resulted. The player was discouraged from continuing playing of the machine or returning to the machine later.

In response to that prior art problem, Ugawa provided an arrangement in which there can never be an alignment of identical symbols that represent a loss, i.e., “loser symbols”. Any combination of three identical symbols on the three reel sheets, shown in Figure 22 of Ugawa, when the reels stop spinning, is a winner. This result is achieved in Ugawa very simply, namely by assuring at least that one of the “loser” symbols, i.e., the watermelon and the bell, is respectively absent from at least one of the three reels of Figure 22. No watermelon appears on the left reel and no bell appears on the right reel in that Figure 22. Thus, there can never be a horizontal alignment of three bells or three watermelons, only of three “7”s and three “BARS”.

Given the foregoing understanding of Ugawa's disclosure, the issue to be resolved in reviewing the final rejection is whether Ugawa's solution, omission of one of the "loser symbols" from one of the reel sheets, suggests, as in claim 17, that *every* symbol employed on any reel sheet *must* appear on each of the reel sheets. Clearly, this claimed arrangement is entirely contrary to Ugawa. Ugawa solves the problem at hand by omitting symbols, not by requiring the presence of each symbol on each reel and the presence of one symbol, serially, without interruption, on each of the reels. The invention as defined by claim 17 is not an inversion nor a duplication of what is described in Ugawa. The invention provides an entirely novel solution to the same problem, a solution different from and not suggested by the Ugawa solution.

The arrangement of symbols of claim 17 can never be considered a "mere duplication" of what is shown in Figure 22 of Ugawa. In fact, it is limitless speculation to attempt to divine what "mere duplication" of the arrangement of symbols of Figure 22 of Ugawa might be. While claim 17 is not confined by the specific embodiment of the symbols on the reels of Figure 1, an incredibly complicated, if not imaginary, process would be required to transform the symbol arrangement of Figure 22 of Ugawa into the symbol arrangement of Figure 1 of the patent application. The final rejection provides no road map for that transformation from Ugawa to the invention.

There is simply no basis in the final rejection, not even a phantom secondary reference, that provides either the difference between Ugawa and the invention or any motivation for altering Ugawa to produce the invention as defined by claims 17-32 of the patent application.³ Therefore, the rejection of all claims as obvious over Ugawa must be reversed.

Argument - Dependent Claims

Reversal of the rejection of the sole independent claim, claim 17, eliminates the need to consider the rejections of dependent claims 18-32. However, the rejections of the

³ Claim 17 requires a display window for viewing symbols on the reels along each of *at least two* straight lines when the reels are stopped. Ugawa clearly fails to meet this limitation of claim 1 as most clearly shown in Figure 20 of Ugawa. The windows 202, 203, and 204 shown in that figure can display only one symbol at a time. However, at this time, Appellant does not rely upon this additional difference from Ugawa for the patentability of claims 17-32.

dependent claims provide additional grounds for reversal with respect to most of the dependent claims.

Claims 20, 22, 23, 25-27, and 29-32 were rejected over Ugawa based upon Official Notice. Appellant traversed all of these rejections and requested, seasonably, that if the Examiner intended to maintain the rejections that publications be cited to supply support for each instance of Official Notice. No such publications were ever cited. Thus, the rejections of these claims are all legally deficient and cannot properly be sustained. Although the limitations of some dependent claims, read in isolation, might represent features of slot machines known in the art at the time of the filing of the present patent application, that knowledge alone is not sufficient to establish that any of the claims rejected based on Official Notice is unpatentable. The issue to be considered, if it is assumed that the limitation of any particular dependent claim was known in the art, is whether it would have been obvious, based upon that knowledge, to have modified Ugawa to produce the invention claimed. Without prior art publications, that issue cannot be resolved. The purported combinations based upon Official Notice are improper so that the corresponding rejections must be reversed.

Dependent claim 18 specifies that the display window provides that symbols appearing on the reels, when the reels are stopped, are visible along each of three straight lines. Ugawa provides for viewing of symbols on three reels only along one straight line because each window displays only a single symbol. This difference between the display according to claim 18 and Ugawa was not addressed in the final rejection. Instead, the Examiner only commented on the second part of claim 18. The rejection is clearly erroneous as to claim 18 and as to claims 19-22, claims that depend directly or indirectly from dependent claim 18.

Claims 20-22 all refer to establishing a winning combination of symbols within the display along diagonal lines that are oblique to the common axis about which the reels rotate. Ugawa's display only displays symbols along a single straight line that is parallel to, not oblique to, the axis about which the reels rotate. The final rejection provides no basis for modifying Ugawa to encompass a display of nine symbols and providing five straight lines, two diagonal and three parallel to the axis of rotation of the reels, as in the embodiments of Figures 2-7 of the patent application and claims 20-22 along which win states can be established.

While reliance upon Official Notice in rejecting claims 20 and 22 might be based upon slot machines displaying a matrix of nine symbols and having three reels, how that kind of display could be adapted to the objective of Ugawa, i.e., avoiding player confusion when common symbols align along a straight line yet produce a non-winning state, is not explained anywhere in the rejection. Accordingly, the rejection of 20-22 claims should be reversed.

Claim 21, incorporating all of the limitations of claims 17-19, further specifies that a repeating symbol on at least one of the reels is part of at least one of the combinations providing a winning state. In rejecting this dependent claim, the Examiner stated that Ugawa teaches a display of one symbol appearing serially at least two times, directing attention to Figure 22 of Ugawa. While the Examiner's statement is, by itself, correct, it does not take into account all of the limitations of claim 21. No winning state symbol in Ugawa, i.e., either a "7" or a "bar" ever appears on any reel sheet serially, at least two times, without any intervening different symbol. How Ugawa's objective would be attained if such a change were made in the Ugawa symbol arrangement is not apparent from Ugawa or the final rejection. Therefore, that difference demonstrates that the rejection of claim 21 is erroneous.

Claim 23 specifies that the repeating symbols appear at least three times on each reel. While the watermelon symbol appears at least three times on one of the reels of Ugawa's Figure 22, there is no such repetition on each reel. The Examiner asserted that modifying Ugawa to meet the limitation of claim 23 would be "mere duplication". This statement is incorrect because the addition of such symbols, whether winning symbols or loser symbols, would alter the potential results of the Ugawa game and might undermine Ugawa's objective. Therefore, the rejection is at least incomplete for failing to demonstrate that making such a modification of Ugawa would be consistent with and therefore obvious over Ugawa. This rejection of claim 23 cannot properly be sustained.

Claim 25 specifies that each of the symbols on each of the reels that appear serially without intervening different symbols is different on each of the reels. As already noted, only two of the reels in Figure 22 of Ugawa include a serially repeating symbol. There is no repetition of any symbol on the center reel of Figure 22 of Ugawa. To supply this acknowledged difference, reliance was placed upon both Official Notice and mere duplication. As with the other rejections, this rejection is both legally and factually

defective because no secondary reference was cited and because there was no explanation of how “mere duplication” could or would modify Ugawa in a way that would be consistent with achieving the objective of Ugawa. The rejection of claim 25 must be reversed.

Claim 26 specifies that the repeating symbols are part of a winning state for a player. The only winning symbols in Ugawa are the “7” and the “BAR”. Neither of those symbols is every repeated without intervening different symbols on any reel sheet in Ugawa. Clearly, making the modification of Ugawa necessary to meet claim 26 would alter the probability of achieving a winning state in Ugawa and at least potentially interfere with achieving the objective of Ugawa. Thus, as in other rejections, unsupported “Official Notice” and failure to explain how hypothetical modification of Ugawa to meet the terms of claims 26, consistent with Ugawa’s objective, demonstrate that the rejection of claim 26 cannot be sustained.

Claim 28 specifies that each of the repeating symbols that appears, in repetition, on one of the reels also appears on each of the other reels, but not serially on those other reels. As in the rejection of claim 21, the Examiner failed to give meaning to all of the language of claim 28. The rejection merely states that Ugawa displays one symbol appearing serially at least two times. What Ugawa shows in Figure 22 is two repeating loser symbols in the left reel and four repeating loser symbols in the right reel. What Ugawa intentionally does not display is the loser watermelon symbol on each of the reels or the loser bell symbol on each of the reels. In fact, the very basis of Ugawa is the omission from particular reels of these repeated loser symbols. The basis of the rejection of claim 28 is fundamentally contrary to the disclosure of Ugawa and therefore that rejection must be reversed.

The rejections of claims 29-32 are simply deficient for failure to address the specific limitations of those claims. Claim 29 was rejected on the same basis that claim 22 was rejected, but there is no similarity between those two claims. Proper rejection of claim 29 would require citation of a prior art publication, a citation that was never made.

The common rejection of claims 30 and 31 fails to acknowledge the claimed arrangement of alignments of symbols along each of either two horizontal lines or two diagonal lines as providing a possibility of winning a game. These limitations are not

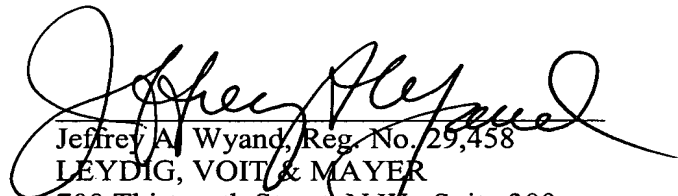
present in Ugawa. The final rejection does not address the language of these claims. The rejection is, therefore, deficient.

Claim 32 was commonly rejected with claims 23, 26, and 27, although the limitation of claim 32 is clearly distinct from each of those three claims. Claim 32 specifies that at least one of the repeating symbols is part of a winning state. By contrast, in Ugawa, the only repeating symbols on the reels are loser symbols. This difference is not "mere duplication" and no support has been provided for the alternative, Official Notice, rejection of claim 32. The final rejection cannot be properly affirmed as to any of claims 29-32.

Summary

The final rejection has failed to establish *prima facie* obviousness as to claim 17, and, therefore, of claims 17-32, over Ugawa considered by itself. Further, for the detailed reasons provided, the rejections of the dependent claims 18-32 are likewise legally and factually defective. *Prima facie* obviousness has not been established with respect to any claim pending in this patent application. Therefore, the rejection, as to all claims, must be reversed.

Respectfully submitted,



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Date: December 27, 2005
JAW:ves

Claims Appendix

17. A display for a game comprising:
a plurality of independently rotatable reels, rotatable about a common axis;
a respective reel sheet attached peripherally to each of the reels, each reel sheet including a plurality of symbols sequentially arranged, for viewing by a player upon stopping of rotation of the corresponding reel, wherein each of the reel sheets includes one symbol appearing serially, at least two times, without any intervening different symbol, and each symbol of the plurality of symbols appears on each of the reel sheets;
and
a display window for viewing symbols on the reels along each of at least two straight lines when the reels are stopped, wherein alignments on at least one of the lines of any of specific combinations of the symbols provide a winning state for the player and all other combinations of the symbols on the straight lines do not provide a winning state for the player.

18. The display for a game according to claim 17 wherein the display window provides for viewing of the symbols, when the reels are stopped, along three straight lines, and alignments on at least one of the three straight lines of any of the specific combinations of the symbols provide a winning state for the player and all other combinations of the symbols on the three straight lines do not provide a winning state for the player.

19. The display for a game according to claim 18 wherein the display includes three reels.

20. The display for a game according to claim 19 wherein any of the specific combinations of three of the symbols aligned on diagonal lines, oblique to the common axis, provides a winning state for the player and all other combinations of the symbols on the diagonal lines do not provide a winning state for the player.

21. The display for a game according to claim 20 wherein one of the symbols appearing serially at least two times, without any intervening different symbol, on at least one of the reels, is part of at least one of the specific combinations providing a winning state for the player when the symbol appears on one of the diagonal lines.

22. The display for a game according to claim 20 wherein one of the symbols appearing serially at least two times, without any intervening different symbol on at least one of the reels, is part of at least one of the combinations not providing a winning state for the player when the symbol appears on one of the diagonal lines.

23. The display for a game according to claim 17 wherein the symbols on each reel appearing at least two times without any intervening different symbol, appear three times on each reel serially, without any intervening different symbol.

24. The display for a game according to claim 17 wherein each of the symbols appearing serially on each of the reels at least two times without any intervening different symbol are different in color on each reel.

25. The display for a game according to claim 17 wherein each of the symbols appearing serially on each of the reels at least two times without any intervening different symbol is different on each of the reels.

26. The display for a game according to claim 17 wherein one of the symbols appearing serially at least two times, without any intervening different symbol, on at least one of the reels, is part of at least one of the specific combinations providing a winning state for the player when the symbol appears on one of the straight lines.

27. The display for a game according to claim 17 wherein one of the symbols appearing serially at least two times, without any intervening different symbol, on at least one of the reels, is part of at least one of the combinations not providing a winning state for the player when the symbol appears on one of the straight lines.

28. The display for a game according to claim 17 wherein each symbol that appears serially at least two times, without any intervening different symbol on one of the reels, also appears on each of the other reels, but not serially without any intervening different symbol.

29. The display for a game according to claim 17 further including a cabinet housing the reels and on which an award table showing the specific combinations of the symbols providing a winning state is displayed for viewing by the player.

30. The display for a game according to claim 17 wherein the at least two straight lines are parallel to the common axis.

31. The display for a game according to claim 17 wherein the at least two straight lines are oblique to the common axis.

32. The display for a game according to claim 17 wherein the specific combinations of the symbols providing a winning state include any one of the symbols of the plurality of symbols that appears identically along any of the straight lines of the display window without interruption by any other symbol.

Evidence Appendix

No evidence was submitted by way of declaration in the course of the prosecution of the patent application.

Related Proceedings Appendix

There are no related proceedings.